

Customer No. 26308

Docket No. 1406.17406-PROV FOR CIP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEW APPLICATION TRANSMITTAL Under 37 CFR § 1.53(b)

Transmitted herewith for filing is the patent application of

Inventor(s): John Sinko

WARNING: 37 C.F.R. § 1.41(a)(1) points out:

(a) A patent is applied for in the name or names of the actual inventor or inventors.

- (1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(c). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors.

For (title): **Corrosion Inhibitor Composition Applicable for Aluminum and Steel Protection and Procedure**

1. **Type of Application**

This new application is for a(n)

- ☐ Original (nonprovisional)
☐ Design
☐ Plant

NOTE: If one of the following 3 items apply then complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF A PRIOR U.S. APPLICATION CLAIMED and a NOTIFICATION IN PARENT APPLICATION OF THE FILING OF THIS CONTINUATION APPLICATION.

- ☐ Divisional.
☐ Continuation.
☒ Continuation-in-part (C-I-P).

2. **Benefit of Prior U.S. Application(s) (35 U.S.C. 119(e), 120, or 121)**

- ☒ The new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

CERTIFICATION UNDER 37 C.F.R. 1.10*

I hereby certify that this New Application Transmittal and the documents referred to as attached therein are being deposited with the United States Postal Service on this date 23 February 2004, in an envelope as 'Express Mail Post Office to Addressee' mailing Label Number EV 318693053 US, addressed as follows: Mail Stop Patent Application, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

Julie Wolf

(type or print name of person mailing paper)

Julie A. Wolf
Signature of person mailing paper

(Application Transmittal - page 1 of 5)

3. Papers Enclosed

A. Required for filing date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. § 1.153 Design) Application

<u>32</u>	Pages of specification
<u>10</u>	Pages of claims
<u>2</u>	Abstract
<u>13</u>	Sheets of drawing
<input type="checkbox"/>	formal
<input checked="" type="checkbox"/>	informal

B. Other documents enclosed: _____

4. Additional papers enclosed

- ☐ Preliminary Amendment
- ☒ Information Disclosure Statement (37 C.F.R. 1.98)
- ☒ Form PTO-1449 (PTO/SB/08A and 08B)
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☐ Other

5. Declaration or oath

- ☐ Enclosed
 - ☐ newly executed
 - ☐ copy from parent application identified above
- Executed by (*check all applicable boxes*)
 - ☐ inventor(s).
 - ☐ legal representative of inventor(s).
 - ☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
 - ☐ This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See Item 13 below for fee.
- ☒ Not Enclosed.
 - ☒ Application is made by a person authorized under 37 C.F.R. 1.41(c) on behalf of all the above named inventor(s). (The declaration or oath, along with the surcharge required by 37 CFR 1.16(e) can be filed subsequently).

6. Inventorship Statement

The inventorship for all the claims in this application are:

- ☒ The same.
- ☐ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made
 - ☐ is submitted.
 - ☐ will be submitted.

7. **Language**

☒ English

☐ Non-English

☐ The attached translation includes a statement that the translation is accurate. 37 C.F.R. 1.52(d).

8. **Assignment**

☒ An assignment of the Invention to Wayne Pigment Corp.

☐ is attached. A separate ☐ COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION or ☐ FORM PTO 1595 is also attached.

☒ will follow.

☒ was filed in the parent application identified above

9. **CERTIFIED COPY**

Certified copy(ies) of application(s)

Country	Appln. No.	Filed
Country	Appln. No.	Filed
Country	Appln. No.	Filed
Country	Appln. No.	Filed

from which priority is claimed

☐ is (are) attached.

☐ will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 CFR 1.55(a) and 1.63.

10. **Fee Calculation (37 C.F.R. 1.16)**

A. ☒ Regular application

CLAIMS AS FILED					
	Number Filed	Number Included in Basic Fee	Number Extra	Rate	Basic Fee 37 CFR 1.16(a) \$770.00
Total Claims 37 CFR 1.16(c)	36	-20 =	16	x \$ 18.00	\$288
Independent Claims (37 CFR 1.16(b))	9	-3 =	6	x \$ 86.00	\$516
Multiple Dependent claim(s) if any (37 CFR 1.16(d))	0			\$290.00	\$0
FILING FEE CALCULATION					\$1,574

☐ Amendment cancelling extra claims enclosed.

☐ Amendment deleting multiple-dependencies enclosed.

☐ Fee for extra claims is not being paid at this time.

Filing Fee Calculation

\$1,574.00

- B. ☐ Design application
(\$340.00 - 37 CFR 1.16(f))
Filing Fee Calculation _____
- C. ☐ Plant application
(\$530.00 - 37 CFR 1.16(g))
Filing Fee Calculation _____

11. Small Entity Statement

- ☒ The applicant is a Small Entity as defined by 37 CFR 1.9 and 1.27 and is entitled to small entity status.
☒ Small Entity Filing Fee: \$787.00

12. Fee Payment Being Made at This Time

- ☒ Not Enclosed
☒ No filing fee is to be paid at this time.
(This and the surcharge required by 37 C.F.R. 1.16(e) can be paid subsequently.)
- ☐ Enclosed
- | | |
|---|----------------------|
| <input type="checkbox"/> Filing fee | _____ |
| <input type="checkbox"/> Recording assignment
(\$40.00; 37 C.F.R. 1.21(h)) | _____ |
| <input type="checkbox"/> Petition fee for filing by other than all the
inventors or person on behalf of the inventor
where inventor refused to sign or cannot be
reached
(\$130.00; 37 C.F.R. 1.47 and 1.17(i)) | _____ |
| <input type="checkbox"/> For processing an application with a
specification in a non-English language
(\$130.00; 37 C.F.R. 1.52(d) and 1.17(k)) | _____ |
| <input type="checkbox"/> Processing and retention fee
(\$130.00; 37 C.F.R. 1.53(d) and 1.21(l)) | _____ |
| <input type="checkbox"/> Fee for international-type search report
(\$40.00; 37 C.F.R. 1.21(e)) | _____ |
| Total fees enclosed | <u>\$0.00</u> |

13. Method of Payment of Fees

- ☐ Check in the amount of \$ _____.
- ☐ Charge Account No. _____ in the amount of _____.
- A duplicate of this transmittal is attached.

14. Authorization to Charge Additional Fees

- ☐ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. _____
- | |
|---|
| <input type="checkbox"/> 37 C.F.R. 1.16(a), (f) or (g) (filing fees) |
| <input type="checkbox"/> 37 C.F.R. 1.16(b), (c) and (d) (presentation of extra claims) |
| <input type="checkbox"/> 37 C.F.R. 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application) |
| <input type="checkbox"/> 37 C.F.R. §§ 1.17(a)(1-5) (extension fees pursuant to § 1.136(a)). |
| <input type="checkbox"/> 37 C.F.R. 1.17 (application processing fees) |
| <input type="checkbox"/> 37 C.F.R. 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. 1.311(b)) |

15. **Instructions as to Overpayment**

☐ Credit Account No. _____
☐ Refund

Reg. No. 38,957

Tel. No.: (262) 783 - 1300

Customer No.: 26308



SIGNATURE OF PRACTITIONER

John M. Manion

(type or print name of attorney)

RYAN KROMHOLZ & MANION, S.C.

(P.O. Address)

Post Office Box 26618

MILWAUKEE, WISCONSIN 53226-0618

☒ **Statement Where Additional Pages are Added**

☒ Plus Added Page for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

☐ **Statement Where No Further Pages Added**

(if no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item)

☐ This transmittal ends with this page.

**ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT
OF PRIOR U.S. APPLICATION(S) CLAIMED**

NOTE: "In order for an application to claim the benefit of a prior filed copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112." 37 CFR 1.78(a).

NOTE: "IN ADDITION THE PRIOR APPLICATION MUST BE (1) COMPLETE AS SET FORTH IN S 1.51, OR (2) ENTITLED TO A FILING DATE AS SET FORTH IN S 1.53(B) AND INCLUDE THE BASIC FILING FEE SET FORTH IN S 1.16; OR (3) ENTITLED TO A FILING DATE AS SET FORTH IN S 1.53(B) AND HAVE PAID THEREIN THE PROCESSING AND RETENTION FEE SET FORTH IN S 1.21(L) WITHIN THE TIME PERIOD SET FORTH IN S 1.53(D)." 37 CFR 1.78(A).

16. Relate Back-35 U.S.C. 120

NOTE: "ANY APPLICATION CLAIMING THE BENEFIT OF A PRIOR FILED COPENDING NATIONAL OR INTERNATIONAL APPLICATION MUST CONTAIN OR BE AMENDED TO CONTAIN IN THE FIRST SENTENCE OF THE SPECIFICATION FOLLOWING THE TITLE A REFERENCE TO SUCH PRIOR APPLICATION IDENTIFYING IT BY SERIAL NUMBER AND FILING DATE OR INTERNATIONAL APPLICATION NUMBER AND INTERNATIONAL FILING DATE AND INDICATING THE RELATIONSHIP OF THE APPLICATIONS." 37 CFR 1.78(A). SEE ALSO THE NOTICE OF APRIL 28, 1987 (1079 O.G. 32 TO 46).

[X] The specification includes the following recitation:

Related Application:

This application is a continuation-in-part application of application Serial No. 10/138,794, filed 3 May 2002, which claims the benefit of provisional application Serial No. 60/288,895, filed 4 May 2001.

NOTE: THE PROPER REFERENCE TO A PRIOR FILED PCT APPLICATION WHICH ENTERED THE U.S. NATIONAL PHASE IS THE U.S. SERIAL NUMBER AND THE FILING DATE OF THE PCT APPLICATION WHICH DESIGNATED THE U.S.

NOTE: (1) WHERE THE APPLICATION BEING TRANSMITTED ADDS SUBJECT MATTER TO THE INTERNATIONAL APPLICATION THEN THE FILING CAN BE AS A CONTINUATION-IN-PART OR (2) IT IS DESIRED TO DO SO FOR OTHER REASONS, E.G. WHERE NO DECLARATION IS AVAILABLE, NO ENGLISH TRANSLATION IS AVAILABLE OR NO FEE IS TO BE PAID ON FILING THEN THE FILING CAN BE AS A CONTINUATION. IN THESE CASES THE INTERNATIONAL APPLICATION DESIGNATING THE U.S. IS TREATED AS THE PARENT CASE IN THE U.S. AND IS AN ALTERNATIVE TO THE COMPLETION OF THE INTERNATIONAL APPLICATION UNDER 35 U.S.C. 371(C)(4) WHICH MUST MEET THE REQUIREMENTS OF 37 CFR 1.61(A). THIS ALTERNATIVE PERMITS THE COMPLETION OF THE FILING REQUIREMENTS WITHIN ANY TERM SET BY THE PTO UNDER 37 CFR 1.53(D) TO WHICH THE EXTENSION PROVISIONS OF 37 CFR 1.136(A) APPLY. (WHEREAS, IF THE FILING IS AS AN INTERNATIONAL APPLICATION ENTERING THE U.S. STAGE THEN THE FEE, DECLARATION AND/OR ENGLISH TRANSLATION (WHERE NECESSARY) IS DUE WITHIN 20 MONTHS OF THE PRIORITY DATE BUT CAN BE PAID WITHIN 22 MONTHS OF THE PRIORITY DATE (OR IS DUE WITHIN 30 MONTHS OF THE PRIORITY DATE BUT CAN BE SUBMITTED WITHIN 32 MONTHS OF THE PRIORITY DATE) WITH THE SURCHARGES SET FORTH IN 37 CFR 1.492(E), (F) AND 37 CFR 1.495(C); HOWEVER, THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THIS 22 OR (32 MONTH) PERIOD. 37 CFR 1.61(B).)

NOTE: THE DEADLINE FOR ENTERING THE NATIONAL PHASE IN THE U.S. FOR AN INTERNATIONAL APPLICATION WAS CLARIFIED IN THE NOTICE OF APRIL 28, 1987 (1079 O.G. 32 TO 46) AS FOLLOWS:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30

months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of S 1.494 and paragraph (i) of S 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

17. Relate Back-35 U.S.C. 119 Priority Claim for Prior Application

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17, in turn itself claim(s) foreign priority (ies) as follows:

country	appl. no.	filed on
The certified copy (ies) has (have)		
<input type="checkbox"/>	been filed on _____	in prior application _____ which was filed on ____.
<input type="checkbox"/>	is (are) attached	

WARNING: The Certified Copy of the priority application which may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a Certified Copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. Serial Number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the continuing application are substantial. Accordingly, the priority documents in folders of international applications which have not entered the national stage may not be relied on.

18. Maintenance of Copendency of Prior Application

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application.

- A. ☒ Extension of time in prior application**
- ☒ A petition, fee and response extends the term in the pending prior application until 23 February 2004.
- ☒ A copy of the petition filed in prior application is attached
- B. ☐ Conditional Petition for Extension of Time in Prior Application**
- ☐ A conditional petition for extension of time is being filed in the pending prior application.
- ☐ A copy of the conditional petition filed in the prior application is attached

19. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

NOTE: If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application. 37 CFR 1.62(a)

NOTE: In the case of a continuation-in-part application which adds and claims additional disclosure by amendment, an oath or declaration as required by § 1.63 must be filed. In those situations where a new oath or declaration is required due to additional subject matter being claimed, additional inventors may be named in the continuing application. In a continuation or divisional application which discloses and claims only subject matter disclosed in a prior application, no additional oath or declaration is required and the application must name as inventors the same or less than all the inventors in the prior application. 37 cfr 1.60(c). (Dealing with the continuation situation).

- (a) ☐ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are
☐ the same.
☐ the following inventor(s) have been deleted:

☐ the following inventor(s) have been added:

- (b) ☐ This application discloses and claims additional disclosure and a new declaration or oath is being filed. With respect to the prior application the inventor(s) in this application are
☐ the same.
☐ the following inventor(s) have been deleted:

☐ the following inventor(s) have been added:

- (c) The inventorship for all the claims in this application are
☒ the same.
☐ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made
☐ is submitted.
☐ will be submitted.

20. Abandonment of Prior Application (if applicable)

- ☒ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

NOTE: ACCORDING TO THE NOTICE OF MAY 13, 1983 (103, TMOG 6-7) THE FILING OF A CONTINUATION OR CONTINUATION-IN-PART APPLICATION IS A PROPER RESPONSE WITH RESPECT TO A PETITION FOR EXTENSION OF TIME OR A PETITION TO REVIVE AND SHOULD INCLUDE THE EXPRESS ABANDONMENT OF THE PRIOR APPLICATION CONDITIONED UPON THE GRANTING OF THE PETITION AND THE GRANTING OF A FILING DATE TO THE CONTINUING APPLICATION.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Sinko, John

Group Art Unit: 1742

Serial No.: 10/138,794

Examiner: Oltmans, Andrew L.

Filed: 3 May 2002

For: Corrosion Inhibitor Composition Applicable for Aluminum and Steel
Protection and ProcedureCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COPY

AMENDMENT, PETITION AND FEE FOR EXTENSION OF TIME TO MAINTAIN
PARENT CASE WHICH IS TO BE ABANDONED WHEN FILING NEW
APPLICATION CLAIMING ITS BENEFIT

NOTE: Where an extension of time is sought solely for the purpose of filing a continuation application under 35 USC 120 and where the prior application is to be abandoned in favor of the continuing application, the filing of a response as required by 37 CFR 1.111 or 1.113 is considered to be an unnecessary expenditure of resources by the applicant and, in these situations, the PTO will accept the filing of a continuing application as a response under 37 CFR 1.136. Notice of May 13, 1983 (1031 OG 11).

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

1. The amendment in this case is a bona fide attempt by applicant to respond and to advance this application to final action and comprises a separately filed:

(check (a), (b) or (c) as applicable)

- (a) ☐ Continuation application
(b) ☒ Continuation-in-part application
(c) ☐ Divisional application (WHERE PARENT CASE IS TO BE ABANDONED)

A copy of this amendment and petition is being filed with the papers constituting the filing of the separately filed application.

NOTE: EACH PAPER OR FEE REFERRED TO AS ENCLOSED HEREIN HAS THE NUMBER OF THE "EXPRESS MAIL LABEL PLACED THEREON PRIOR TO MAILING. 37 CFR 1.16(B).

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this paper and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date 23 February 2004 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EV 318693053 US addressed as follows: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

Julie A. Wolf

(Type or Print Name of person mailing paper)

Julie A. Wolf

(Signature of person mailing paper)

NOTE: An express mail certificate under 37 CFR 1.10 and the "WARNING" below is shown on the presumption that this paper will be mailed with the new application

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 CFR 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

2. This is a petition under 37 CFR 1.136(a) for an extension of time to respond to

(check and complete (d) or (e) as applicable)

(d) ☒ the Office Action mailed 23 September 2003
(e) ☐ (OTHER) _____

3. Please abandon this application conditioned upon the granting of the petition and the granting of a filing date to the continuing application so as to make the continuing application copending with this application. (NOTICE OF MAY 13, 1983, 1031 O.G. 11-12).

4. Applicant is

☒ a small entity
☐ other than a small entity

5. Extension requested

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

- (a) ☒ Applicant petitions for an extension of time under 37 CFR 1.136(a) (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

	<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input checked="" type="checkbox"/>	two months	\$ 420.00	\$210.00
<input type="checkbox"/>	three months	\$ 950.00	\$475.00
<input type="checkbox"/>	four months	\$1,480.00	\$740.00

Fee \$ 210.00

If an additional extension of time is required please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

6. Fee payment

☒ Attached is a check in the sum of \$ 210.00.

☐ Charge Account No. _____ the sum of \$ _____.

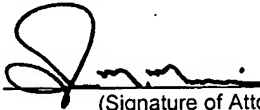
A duplicate of this transmittal is attached.

7. Fee deficiency

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the NOTICE OF APRIL 7, 1986, (1065 O.G. 31-33).

☒ If any additional extension and/or fee is required, charge Account No. 06-2360.

Reg. No. 38,957
Tel. No.: (262) 783-1300
Customer No. 26308


(Signature of Attorney)
John M. Manion
RYAN KROMHOLZ & MANION S.C.
POST OFFICE BOX 26618
MILWAUKEE, WISCONSIN 53226-0618